UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/126,007	07/29/1998	YOJI KAWAMOTO	SONY-P8779	8417

22850 7590 04/10/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER
CRAVER, CHARLES R

ART UNIT	PAPER NUMBER
2682	16

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/126,007	Kawamoto
Examiner	**Art Unit**
Charles Craver	2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 13, 2002*.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-101* is/are pending in the application.

4a) Of the above, claim(s) *6-11, 15-49, 51, 53-55, 58-63, 66-72, 75-81, 83,* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-5, 12-14, 50, 52, 73, 74, 82, 84, 86, and 88-91* is/are rejected.

7) ☒ Claim(s) *56, 57, 64, and 65* is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☒ The proposed drawing correction filed on *Aug 22, 2000* is: a) ☒ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *5 6 9*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of claims 1-5, 12-15, 50, 52, 56, 57, 64, 65, 73, 74, 82, 84, 86 and 88-91 in Paper No. 15 is acknowledged. The traversal is on the ground(s) that the examination of the entire claimed invention would not be a serious burden on the examiner. This is not found persuasive because, while in some cases a publication may comprise a combination of inventions, such is not always present in the prior art. Further, while it is true that a number of US Patents have been issued in more than one subclass, said subclasses are directly related to each other, and in the instant invention the Groups of inventions may be operable separately, in which case the search subclasses are not as closely related as in the previous example. As such, because of the burden on the examiner for the search of the combination of inventions, the requirement is still deemed proper and is therefore made FINAL.

2. Note also that the initial restriction requirement contained a typographical error, including claims 15 and 75 in both Groups I and III, when in fact said claims are a part of Group III, and wherein claim 74 is in Group I. As such, claims 15 and 75 will be assumed to be a part of the non-elected invention, and will not be examined on its merits.

3. This application contains claims 6-11, 15-49, 51, 53-55, 58-63, 66-72, 75-81, 83, 85, 87 and 92-101 drawn to an invention nonelected with traverse in Paper No. 15. A complete reply to

the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 1, 3, 4, 12, 14, 50, 52, 73, 82 and 84 are rejected under 35 U.S.C. 102(e) as being anticipated by Abo et al, US Patent 5,948,041.

Claims 1, 12, 82 and 84: Abo discloses an information processing apparatus (20) embodying a program of instructions adapted to exchange information with a second information processing apparatus (10, see FIG 1) comprising

input device means for capturing information (25, col 3 lines 59-67), inherently comprising memory means for storing the captured information,

acquisition circuit means (23) for acquiring data associated with said captured information (col 3 lines 49-58), on the basis of said information, and

display means (24) for displaying the acquired data (col 4 lines 5-19, col 1 lines 47-67).

Claims 3 and 14: Abo discloses that the acquired information is stored in a database (21).

Claims 4 and 73: the inventions of claims 4 and 73 are the method inherently performed by the apparatus invention of claims 1 and 12, and as such is rejected using the same reasoning as set forth above.

Claims 50 and 52: Abo discloses that the radio connection is a telephone (reads cellular) connection (col 8 lines 3-5).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2, 5, 13, 74, 86 and 88-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abo et al.

Claim 2: Abo discloses applicant's invention of claim 1 as set forth above, and further discloses means to transmit information and receive the acquired data (e.g. map data) from the other communication device (col lines), but fails to disclose that the transmitted information is the captured information, that is, that the acquired data is received in response to the transmission of the captured data.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a step to Abo, as such would have reduced the amount of acquired data

needed to be sent. In the case of Abo, a large amount of data is needed to be sent because Abo discloses that the acquired data is sent en masse to the mobile unit before the location is determined. By sending only the e.g. map data which is needed (i.e. only that which immediately surrounds the mobile), less data needs to be sent to the mobile and bandwidth is saved, as well as storage space.

Claim 5: while Abo discloses a transmission medium and a controller 23 inherently using a program, but fails to disclose that the program may be sent via the medium, such was notoriously well known in the art at the time of the invention, and as such Official Notice of such a feature is taken. It would have been obvious to one of ordinary skill in the art at the time of the invention to allow the mobile to be programmable, as such allows the mobile software to be updated without needing to bring the mobile into a physical location.

Claims 13, 86, 88 and 90: please see the rejection of claim 2 above.

Claim 74: the use of a floppy disk would have been an obvious choice for the database 21, as such is portable.

Claims 89 and 91: Abo discloses that the radio connection is a telephone (reads cellular) connection (col 8 lines 3-5).

Allowable Subject Matter

8. Claims 56, 57, 64 and 65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

Claims 56, 57, 64 and 65 all teach towards an information processing apparatus comprising means for capturing and storing information, means for acquiring data associated with said captured information on the basis of said information, and means for displaying the acquired data, wherein the data includes a song title, a singer's name, a composer's name, a songwriter's name or a genre.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yogo, Hull and Ishida disclose means to send and receive captured data and related data.

11. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 872-9314 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, sixth floor (receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin, can be reached on (703) 308-6739.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

cc

C. Craver
April 3, 2003

4-3-03
CHARLES CRAVER
PATENT EXAMINER